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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,222	08/02/2005	Michael Smolong	48753	9493
1609 7590 11/28/2007 ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036			EXAMINER IRVIN, THOMAS W	
			ART UNIT 3683	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/544,222

Applicant(s)

SMOLONG ET AL.

Examiner

Thomas W. Irvin

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050802</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 1, 2, 4, 5, and 8 objected to because of the following informalities: in claim 1, line 4 "on one gear stage" should be changed to read -- near one gear stage --; in claim 2, line 3, "which immersion bath has" should be changed to read -- which has --; in claim 4, 5, and 8, line 1 the deletion of "s" on the end of claims should be written -- claim[s] --; in claim 5, lines 4 and 5, have grammatical errors. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 provides for the use of a filter, as described in DE 10105612 A1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ward (5,279,391).

'391 discloses a dry sump mechanical transmission, with multiple gear stages (26,28,30,32,34), which are mounted next to one another and which are dynamically connected to one another, and a lubricant circuit to which at least one filter unit (48) is connected, characterized in that the lubricant is drawn off via an inlet (46) of a pump (44) near one gear stage (26), and then cleaned by the filter unit, and can then be supplied to the respective other gear stage (34) through a nozzle (51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (5,279,391) in view of Hauser (4,420,990).

In Re claims 2 and 3, '391 further discloses that the lubrication oil flows from one gear stage to the next and down to a bath area (42) and inlet of the lubricant circuit. '391 discloses the claimed invention except failing to teach divisions to separate the gears. '990 teaches adding a filler (18) to the inside of the transmission casing (11) which separates the gears (A,B,C) such that they have separate immersion baths which are filled with lubricating oil. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission, taught by '391, to include transmission filler, as taught by '990, to occupy most of the space in a transmission between the gears and the housing (11), thus reducing the amount of lubricant necessary to lubricate the gears.

In Re claims 5-7, '391 further discloses a suction device, motor pump (44), an injection device, nozzle (51), mounted diagonally opposite one another in the upper and lower area of the transmission housing.

In Re claim 7, '391 further discloses that the filter unit (48) is mounted between the motor pump unit (44) and gear housing (12) in the lubricant circuit.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (5,279,391) in view of Hauser (4,420,990), as applied to claim 7, and further in view of Sann et al. (7,279,091).

In Re claims 8 and 9, '391 as modified, teach the claimed invention except failing to teach the specifics of the filter unit. '091 teaches a filter unit (10) having a first fine filter (12), which is safeguarded with a bypass (22), and a coarse filter (32) connected in series with the first filter. The filter fineness of the coarse filter is approximately 5 to 10 times greater than the filter fineness of the fine filter. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission, taught by '391 as modified by '990, to include a filter unit with two filters and a bypass, as taught by '091, to fully strain the lubrication oil of any contaminants.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeson (3,582,998) in view of Ward (5,279,391).

'998 disclose a speed changing mechanism, which includes a planet gear (6) and a spur gear (24), which are dynamically connected to one another. '998 fails to disclose a lubricant circuit.

'391 teaches using a dry sump lubricant circuit with a mechanical transmission. The lubricant circuit including at least one filter unit (48), characterized in that the

lubricant is drawn off via an inlet (46) of a pump (44), and then cleaned by the filter unit, and can then be supplied to the respective gear stage (34) through a nozzle (51).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the speed changing mechanism, taught by '998, to include a lubricant circuit with an oil filter, as taught by '391, to ensure proper lubrication of all the gears and bearings within the mechanism, and to filter out any impurities in the lubrication oil.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas W. Irvin whose telephone number is (571) 270-3095. The examiner can normally be reached on Mon-Fri 8am-4pm, Alt Fri off (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TWI
11/22/2007


ROBERT A. SICONOLFI
SUPERVISORY PATENT EXAMINER